REMARKS

The present application includes pending claims 1-20, all of which have been rejected. By this Amendment, claims 1, 11, and 18 have been amended as set forth above. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 remain rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,755,744 ("Nathan"). Claims 4, 9, 12, 15, and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan. The Applicant respectfully traverses these rejections at least for the reasons set forth below.

I. The Present Application Claims Priority Benefits From Applications Having Effective Filing Dates That Antedate Nathan

Initially, the Applicant notes that the present application claims priority to application No. 09/309,400, filed May 11, 1999, application No. 09/502,875, filed February 11, 2000, and application No. 09/426,047, filed October 25, 1999. The filing dates of all of these parent applications antedate the filing date, and even the foreign priority dates, of Nathan.

II. Nathan Does Not Explicitly Or Inherently Describe A Single Control Subsystem Coupled To A Game Subsystem And A Jukebox Subsystem That Exercises Control Over The Game And Jukebox Subsystems

The Office Action states the following:

> Nathan clearly discloses a communication device and method for switching operating modes between an electronic game machine and a jukebox (column 3). Nathan describes switching from a game function to a

> jukebox function for selecting and playing music or to pay for credits in order to be able to play a game or a song in the event that none exists (column 4, lines 20-37).

July 15, 2005 Office Action at page 2.

The object of Nathan is to propose a "communication device allowing game machines to be used as terminals for the playback system." Nathan at column 1, lines 26-30. Notably, Nathan only describes a system in which a game machine may be used as a terminal for a playback system, but does not describe a system in which a single control subsystem exercises control over both a game subsystem and a jukebox subsystem.

As discussed previously, Nathan discloses a system in which separate electronic game machines may be used for jukebox selection and payment.

> The principle of the invention is that these electronic game machines 2 can be used as add-on selection means and means of payment for a jukebox, located nearby, in the same bar as the electronic game machines 2.

Id. at column 2, lines 45-48.

The electronic game machines may be used to select between two operating modes of the game machine. *See id.* at column 2, lines 48-50 ("Thus, each electronic game machine comprises a means for selecting between two operating modes."). One of the modes relates to **operation of the electronic game machine**, and the other mode relates to **selection and payment regarding the jukebox**.

> The first operating mode corresponds to the original operating mode of the electronic game machine, i.e., the machine is operating as an electronic game or an internet access station. In this mode and according to a first

> alternative embodiment, no communication is taking place between the jukebox 1 and the electronic game machine 2. In the second operating mode, the electronic game machine 2 is converted into an add-on selection means and a means of payment for the jukebox. **In this mode, all the original functionalities are unused to allow for the selection and payment functions of the jukebox 2.**

Id. at column 2, lines 50-60 (emphasis added). Thus, Nathan discloses a system in which a game machine may be operated (1) in its normal operating mode, in which the game machine does NOT communication with the jukebox, and (2) in a jukebox selection and payment mode in which it may be used **only for selection and payment** with respect to the jukebox. Nathan clearly states that in this second mode, the game machine is only used for selection and payment. *See, e.g.,* Nathan at column 3, lines 49-54 ("... of the operation of the electronic game machine 2 in the second operating mode, i.e., in the mode allowing the selection and payment for pieces of music from the jukebox 1.").

Thus, in sum, Nathan discloses a system in which a game machine may be used in a first mode, which is its normal game operating mode without communication with the jukebox, and a second mode, in which it may be used to select and pay for musical pieces contained within the jukebox.

Nathan, however, does not explicitly or inherently describe "a single control subsystem coupled to the game subsystem and the jukebox subsystem... exercising control over the game subsystem and the jukebox subsystem," such as recited in claim 1. While Nathan discloses a system in which a user may select songs and pay for songs from a game machine, Nathan does not disclose a single control subsystem that exercises control over both the game machine and the jukebox. In short, allowing selection and

payment with respect to a jukebox from a separate game machine is not the same as controlling jukebox and game functionality through a single control subsystem. Thus, at least for this reason, the Applicant respectfully submits that Nathan does not anticipate, or render unpatentable, claims 1, 11, or the claims that depend therefrom.

III. Nathan Teaches Away From Some Types Of Electronic Dart Games

Turning now to the rejection of claims 4, 9, 12, and 15, Nathan is clear that the electronic game machines disclosed in Nathan **must** include a viewing means, such as a video monitor. For example, Nathan discloses the following:

> As a minimum, each electronic game machine 2 **must** originally comprise a **viewing means** 210, such as a **video monitor**, a means for interacting with a user 211, and its own means of payment 220.

Nathan at column 2, lines 38-42 (emphasis added). The Applicant notes, in particular, the use of the word "must." Nathan requires a "viewing means" that allows the viewing of "specific selection screens."

> Indeed, the second operating mode **requires** the viewing **of specific selection screens** as well as different management of the means of payment in comparison with the first operating mode of the electronic game machine 2.

Id. at column 3, lines 37-40 (emphasis added). The Applicant notes the use of the word "requires." In order to view a "selection screen," the viewing means **must** be capable of showing such a selection screen.

The Office Action states that "it is noted that the features upon which applicant relies... are not recited in the rejected claims." *See* July 15, 2005 Office Action at page

3. The Applicant respectfully disagrees. Claims 4, 9, 12, and 15 all recite dart games. Electronic dart game machines may or may not include a separate viewing means, such as a video monitor, that is capable of showing a selection screen. In fact, various electronic dart game machines exist that do not include a viewing means that is capable of showing a selection screen. **Clearly, if Nathan would have considered electronic dart game machines, it certainly would have left open the possibility for those dart game machines that do not include a viewing means that is capable of showing a selection screen.** Nathan, however, does not mention dart game machines at all, and **requires** that its game machines include a viewing means, such as a video monitor, that is capable of showing a selection screen. Thus, it would **not** be obvious to combine a dart game with Nathan, because an entire class of electronic dart games, such as those without viewing means capable of showing a selection screen, are precluded from being used with Nathan. Had Nathan contemplated use of dart games, Nathan clearly would have left open the possibility of utilizing games without the viewing means, because numerous types of electronic dart games do not include a viewing means that is capable of showing a selection screen. As such, the Applicant respectfully submits that Nathan does not render claims 4, 9, 12, and 15 unpatentable at least for this reason.

IV. Incorporating A Game Subsystem And Jukebox Subsystem Into A Single Unit Is Not Merely A Matter Of Engineering Design Choice

The Applicant next turns to the rejection of claims 18-20. Initially, the Applicant notes that these claims should be in condition for allowance, at least for the reasons discussed above with respect to claims 1 and 11. The Office Action concedes that "Nathan does not explicitly [disclose] a single unit housing the integral part of the entertainment system," but asserts that "it has been well settled that by providing a single

unit or housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice." *See* July 15, 2005 Office Action at page 8.

Claim 18 recites a "single unit" that houses the game subsystem, the jukebox subsystem, and the control subsystem. The Applicant respectfully submits that housing the game subsystem and the jukebox subsystem in a single unit is not merely a matter of obvious design choice. First, such game systems and jukebox systems are not normally linked to one another. Next, even Nathan describes game systems and jukebox systems as being separate and distinct. *See* Nathan, e.g., at column 2, lines 45-48 ("The principle of the invention is that these electronic game machines 2 can be used **as add-on** selection means and means and means of payment **for a jukebox 1, located nearby**, in the same bar as the electronic game machines 2.). Nathan simply does not teach or suggest that such systems could be housed within a single unit.

Overall, there has been a need for maximizing the floor space within an establishment, and to reduce the number of operational gaming systems in an establishment, as described in the background section of the present application. *See, e.g.,* ¶¶ [0005 – 0006] ("Electronic entertainment devices and jukeboxes, however, occupy valuable floor space that could otherwise be profitably used, for example, for additional customer seating.... Reducing the number of operational gaming systems in an entertainment establishment may in many instances reduce overall operating expenses"). Housing a gaming system and a jukebox system into a single unit addresses these needs, and should therefore be patentable. *See Shenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed.Cir. 1983). Thus, at least for these reasons, claims 18-20 should be in condition for allowance.

V. Conclusion

The Applicant respectfully submits that claims 1-20 of the present application should be in condition for allowance at least for the reasons discussed above and request reconsideration of the claim rejections. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the Applicant. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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